

Remarks

Claims 1-3, 7-9 and 12-24 are pending in the subject application and currently before the Examiner for consideration. Applicant acknowledges that claims 13-24 have been withdrawn from further consideration as being drawn to a non-elected invention. Favorable consideration of the pending claims is respectfully requested.

Claims 1-3, 7-9 and 12 remain rejected under 35 U.S.C. § 103(a) as obvious over *Parce et al.* (U.S. Published Patent Application No. 2005/0238545) in view of *Voss et al.* (U.S. Patent No. 6,706,162) and in further view of *Thurow* (U.S. Patent No. 4,783,441). The Office Action indicates that *Thurow* provides the motivation of using its block copolymers in order to reap the benefits of their hydrophobic and hydrophilic proportions, which would certainly be useful in *Parce et al.* and *Voss et al.* It is also argued that motivation need not be present in all of the references and that one cannot show non-obviousness by attacking the references individually where the rejections are based upon a combination of references. Finally, the Office Action argues that it would have been obvious to substitute one known element, such as the block copolymers of *Parce et al.* and *Voss et al.*, for another, such as the block copolymers of *Thurow*, because such a substitution would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Applicants note the argument made in the Office Action regarding the obviousness of substituting the block copolymers of *Thurow* for those taught in *Voss et al.* and *Parce et al.*; however, the arguments made in the Office Action fail to establish why one skilled in the art, in the absence of the claims or disclosure of this invention, would have had any reason to substitute or change the types of block copolymers used by either *Parce et al.* or *Voss et al.* As noted by the Board of Patent Appeals in *Ex Parte Joachim Burger*, Appeal 2007-2308 (decided July 12, 2007),

Despite the Examiner's unsupported assertion that person of ordinary skill in the art would have found it obvious to add an additional counterirritant to *Burger's* composition, we find nothing in the combination of references relied upon to suggest the use of more than one counterirritant. Instead, we find that one reading *Burger* and *Bell* in combination would recognize that *Burger's* composition already includes the counterirritant vitamin A and therefore would not have been motivated to add a second counterirritant to *Burger's* composition. As set forth in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (2007), a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common

sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

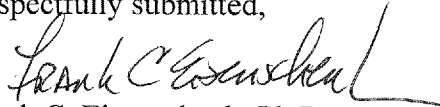
In this case, both Voss *et al.* and Parce *et al.* teach various block copolymers that can be used for the various purposes disclosed within both of the references and nothing in either reference suggests that the use of the block copolymers disclosed therein is inefficient or unsuitable. Thus, there is no basis for suggesting that one skilled in the art would have been motivated to substitute the block copolymers disclosed by Thurow for those taught in Voss *et al.* and/or Parce *et al.* As noted by the Court of Appeals for the Federal Circuit, it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention using applicants' disclosed invention as a template and selecting elements from references to fill the gaps. *In re Gorman*, 933 F.2d 983, 986-987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

In view of the foregoing remarks, Applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



Frank C. Eisenschenk, Ph.D.

Patent Attorney

Registration No. 45,332

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: P.O. Box 142950

Gainesville, FL 32614-2950

FCE/jb/sl